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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,509	01/20/2000	Frank Leymann	12992(GE998-062)	4530

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EXAMINER
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CHOI, KYLE JAEHUN

ART UNIT	PAPER NUMBER
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3623

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DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/488,509

Applicant(s)

LEYMANN ET AL.

Examiner

Kyle J. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The following is an initial Office Action upon examination of the above-identified application on the merits. Claims 1-17 are pending in this application.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

3. It is noted that the specification of the present application lists and discusses multiple prior art references in the "Prior Art" section of the specification. Applicant is reminded that the listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper."

***Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.***

### **Abstract**

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a **single paragraph** on a separate sheet within the **range of 50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because the abstract is too long and it contains more than one paragraph.

Correction is required. See MPEP § 608.01(b).

### **Specification**

6. The disclosure is objected to because of the following informalities:

a. The use of various trademarks (e.g., FLOWMARK) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks

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should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

**b.** Numerous grammatical errors including incorrect use of punctuations are noted throughout the specification.

Although this may be due to translation from the foreign application from which the present application depends, applicant's cooperation is requested in reviewing the specification and correcting these errors since the errors render the specification rather difficult to read and comprehend.

Appropriate correction is required.

#### ***Claim Objections***

**7. Claims 13-17** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In particular, these claims recite a different preamble as if the claim is an independent claim, but attempt to incorporate the recited steps of a previous claim. This style

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of recitation causes confusion as to whether the claim is an independent claim in short form, or a dependent claim.

Furthermore, this style of recitation renders the claims indefinite because it is not clear what the limitations are (see §112 rejection below for details).

a. **Claim 13** recites an [computer program] application comprising "means for using the method in accordance with claim 1". Claim 13 is in improper dependent claim because this claim fails to further limit claim 1 as recited (i.e., reciting an application using the method of claim 1 does not further limit the method).

b. **Claim 14** recites a systems management system comprising "means for using the method in accordance with claim 1". Claim 14 fails to further limit claim 1 for the same reason as stated above for claim 13.

c. **Claims 15-17** all suffer the same deficiency as indicated for claims 13 and 14.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the ***first paragraph*** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and

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use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claims 13 and 14** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, claims 13 and 14 are "single means" claims.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor. (See MPEP §2164.08(a))

10. The following is a quotation of the ***second paragraph*** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. **Claims 1-12, 15-17** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. **Claim 1**, line 8, "their" lacks proper antecedent basis since it is not clear what this is referring to.

b. **Claim 1**, line 20, "said information" lacks proper antecedent basis because it is not clear which information this is referring to. Claim 1 recites "error information", "organizational information", and "staff information" prior to reciting "said information".

c. **Claim 5**, lines 1-2, "**the** step of providing a communication bridge" (emphasis added) lacks antecedent basis. No such step was previously recited.

d. **Claim 5**, line 12, "it" lacks proper antecedent basis. It is not clear what "it" refers to.

e. **Claim 5** seems to be lacking essential steps. In line 13, the step of enhancing said process monitor involves "providing it with a set of predetermined rules in order to manage said business process" but does not recite how this is achieved. In particular, what is the purpose of the set of predetermined rules? There seems to be a step missing



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to apply the set of predetermined rules to achieve the stated goal (i.e., "to manage said business process").

f. **Claim 9**, lines 1-2, "**the** step of providing a communication bridge" (emphasis added) lacks antecedent basis. No such step was previously recited.

g. **Claim 9**, line 11, "it" lacks proper antecedent basis. It is not clear what "it" refers to.

h. **Clam 9** seems to be lacking essential steps. In line 12, the step of enhancing said enterprise console involves "providing it with a set of predetermined rules in order to manage said business process" but does not recite how this is achieved. In particular, what is the purpose of the set of predetermined rules? There seems to be a step missing to apply the set of predetermined rules to achieve the stated goal (i.e., "to manage said business process").

i. **Claims 2-4, 6-8, 10-12** are rejected due to dependency to deficient base claims.

j. **Claim 15**, it is vague and indefinite as to how a "tool" is stored on a data carrier. Furthermore, it is vague and indefinite as to how this "tool" that is apparently embodied on a data carrier "implements" the method of claim 1. Is it not the "computer device" that is the tool and actually implements the method?

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k. **Claims 16 and 17** is vague and indefinite because it is not clear how a "computer program" implements the method of claims 11 and 12, respectively. A computer program can direct a computer device to perform the underlying method, but it is actually the computer device that "implements" the method embodied in the form of a compute program.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Claims 1-17** are rejected under 35 U.S.C. 102(e) as being anticipated by **Gabbita et al.** (US Pat. No. 6,349,238).

Gabbita et al. teaches monitoring workflow processes of an organization such as a telecommunications company for error events (i.e., Jeopardy points; col. 12, ln. 23) and alerts predefined operators in the organization (col. 12, ln. 28). The alerts are in the form of notification messages (col. 12, ln.

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36) containing that the event is, who was assigned to the task, and its priority level (col.12, lns. 44-53). The error events are then either fixed or reassigned (col. 3, lns. 7-10). All of these actions are displayed through the LSAT User Interface (col. 12, ln. 64).

Although Gabbita et al. does not specifically use the term "Systems management system", the monitoring of the workflow process and providing automated management of the workflow events including problems constitute the functionality of systems management systems and therefore is considered to be anticipated by Gabbita et al.

Furthermore, the enterprise console recited is nothing more than a console that manages and displays collected events in a distributed network system. LSAT User Interface and its associated automatic monitoring of the workflow events in Gabbita et al. is therefore considered to be the enterprise console as recited in the claims and is therefore anticipated.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. **Claims 1-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ackroff et al.** (US Pat. No. 5,721,913) in view of **Topff et al.** (US Pat. No. 6,026,500).

Ackroff et al. teaches an integrated activity management system that constitutes workflow management of activities assigned to various operators in the organization in a distributed network environment. The system tracks all the operation of a business (i.e., the business processes) as each

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process moves through the workflow (see at least the Abstract). Ackroff et al. does not teach using SMS to monitor and alert operators of error events that occur in the workflow process.

Topff et al. teaches using SMS to monitor and report error events in a distributed network environment. The SMS in Topff et al. is used to monitor hardware and software errors of the distributed network (col. 3, lns. 32-35) and obtains the details of the error information and events (col. 3, lns. 45-50). The event manager then forwards the error events and associated information automatically to the help desk for resolution of the problem (col. 4, lns. 8-18).

It would have been obvious for one with ordinary skill in the art at the time of the invention to have utilized the automated SMS of Topff et al. in the workflow management system of Ackroff et al. because a workflow management system is necessarily a distributed network system and SMS of Topff et al. manages the events associated with distributed network system. Furthermore, Topff et al. teaches that it would have been advantageous to use SMS to automate the monitoring and reporting procedures of distributed system in the manner taught by Topff et al. because of advantages of efficiency and accuracy of allowing the enterprise console to collect the information and

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forward the events to resolution (col. 1, lns. 30-43; col. 2, 31-49).

### ***Conclusion***

17. ***No claims allowed.***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- ***Burgess et al.*** (US Pat. No. 5,696,701) teaches using modular techniques for monitoring system events and reporting errors.

- ***Dawson et al.*** (US Pat. NO. 6,230,198) teaches server-to-server event logging in distributed network systems using systems (i.e., network) management systems such as Tivoli's enterprise console.

- ***Huhns et al.*** ("*Workflow Agents*") teaches using various autonomous agents to monitor the processes in a workflow system to detect, report, and negotiate exceptions that arise in the network to more efficiently manage the enterprise.

- ***Kellogg et al.*** ("*Interface Management: A CORBA Universal Service Manager*") teaches using object-oriented solutions for providing connectivity between diverse management systems.

- ***Ray*** ("*Designing Enterprise-Oriented Network Management Applications*") teaches designing workflow systems that will be

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flexible enough to detect unforeseen problems during execution and provide intervention measures to resolve the problem efficiently.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kyle J. Choi** whose telephone number is (703)306-5845. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Tariq Hafiz** can be reached on (703)305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is (703)308-1113.

Any response to this action should be mailed to:


**Commissioner of Patents and Trademarks  
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or faxed to:

(703)305-7687 [Official communications; including  
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"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

  
**KYLE J. CHOI**  
**PRIMARY EXAMINER**  
Art Unit 3623  
March 9, 2003